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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/382,421	08/24/1999	JEFFRY JOVAN PHILYAW	PHLY-24.740	5215

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EXAMINER

LUU, LE HIEN

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 08/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/382,421

Applicant(s)

PHILYAW ET AL.

Examiner

Le H Luu

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

1. Claims 1-9 are presented for examination.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant does not clearly describe in the specification that a machine readable code has a relationship to a product or service and a visual indicia has no relationship to the product or service.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 37 1(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1-6 and 8-9 are rejected under 35 U.S.C. § 102(e) as being anticipated by **Perkowski patent no. 6,064,979.**

6. As to claim 1, Perkowski teaches the invention as claimed, including a visual indicia for facilitating computer based access of a network by consumer, comprising:

a machine readable code disposed on a surface having encoded therein information as to a product or a surface, which machine readable code has no routing information contained therein to allow a user to access any location on a network, and which machine readable code has a relationship to the product or service unrelated to routing information (col. 10 lines 14-33; UPC or UPN has relationship to a product or service but has no routing information); and

a visual indicia disposed on said surface in a predetermined proximate orientation to said machine readable code such that the machine readable code and the visual indicia together form a defined composite visual appearance (Perkowski, col. 4 lines 5-23; col. 20 line 9-14; col. 21 lines 52-62; trademark symbol or logo or company name is printed on service or product with bar code), indicative of a relationship between said machine readable code and the presence of a location (Perkowski, URL) on a network and that such location on the network can be accessed by a computer having an appropriate input device (Perkowski, bar code reader or scanner) for reading said machine readable code, such that reading of said machine readable code by said input device will connect the computer to the location, and wherein the visual indicia has no relationship to the product or service (col. 10 line 14 – col. 11 line 16; col. 15 lines 9-43; trademark symbol or logo has no relationship to product or service).

7. As to claims 2-6, Perkowski teaches said visual indicia is not machine readable, aid machine readable code represents a product, machine readable code is disposed on a product, machine readable code is closed association with said product, and machine readable code is a UPN (col. 4 lines 14-22; col. 12 line 65 – col. 13 line 9).

8. As to claim 8, Perkowski teaches said machine readable code is an EAN (col. 6 lines 26-46; EPC reads on EAN which is European Article Numbering).

9. As to claim 9, Perkowski teaches said machine readable device is a scanner (col. 19 lines 38-40).

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 7 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Perkowski** patent no. **6,064,979**.

12. As to claim 7, Perkowski teaches the invention substantially as claimed as discussed above; however, Perkowski does not explicitly teach said machine readable code is an ISBN.

Official Notice is taken that ISBN is well known.

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the well known teaching with Perskowski's system to use ISBN as one of machine readable code because it would allow user to get more information related to a publication.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Le H. Luu, whose telephone number is (703) 305-9650. The examiner can normally be reached Monday through Friday from 7:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia, can be reached at (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 746-7239, (for formal communications; please mark
"EXPEDITED PROCEDURE").

Or:

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(703) 746-7240 (for informal or draft communications, please label
"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington. VA., Sixth Floor (Receptionist).

A handwritten signature in black ink, appearing to read 'Le Hien Luu', with a long horizontal line extending from the end of the signature.

LE HIEN LUU
PRIMARY EXAMINER

August 01, 2003